

REMARKS

Applicants have carefully reviewed the Office Action mailed January 3, 2005, prior to preparing this response. Claims 1-45 are pending in the application, wherein claims 1-7, 9-13, 21-30 and 34-42 are rejected and claims 8, 14-20, 31-33 and 43-45 are objected to for depending from a rejected claim. Applicants thank the Examiner for favorable consideration of the objected claims. Claims 1, 6-10, 14, 19, 34 and 38 have been amended with this response. Favorable consideration of all pending claims is requested.

§102 Rejections

Claims 1-5, 9-13, 21-26 and 34-39 stand rejected under 35 U.S.C. §102(e) as being anticipated by Rosenbluth et al. (U.S. Patent No. 6,685,722). Applicants respectfully traverse this rejection. Claim 1 has been amended to more clearly describe the claimed invention.

As to claim 1, Rosenbluth at least fails to teach a distal protection assembly including an actuator assembly including a button and a gear. To the contrary, Rosenbluth appears to teach a sliding infusion port 630 which may be translated linearly along the handle body 612 either manually or by rotating actuating wheel 646. See column 20, line 25 through column 21, line 7. At no point does Rosenbluth suggest an actuator assembly including a button and a gear as currently claimed. For at least this reason, Applicants assert Rosenbluth does not anticipate claim 1, or likewise, claims 2-5 and 9-13 which depend from claim 1.

As to claim 21, Rosenbluth at least fails to disclose a proximal tubular member including teeth coupled to the proximal end of an outer sheath. Although Rosenbluth suggests teeth on a rack may be provided on the handle body 612 (see column 20, lines 63-65), this is not what is currently claimed. Applicants take the liberty to assume that the Examiner's rejection suggests the handle body 612 is intended to disclose the manifold as currently claimed. If this assumption indeed is correct, then the handle body 612 cannot also be the proximal tubular member since two distinct elements are claimed in the invention. Additionally, the handle body 612 is not coupled to the outer tube 650

since the outer tube 650 is connected to the sliding infusion port 630 (which may be translated linearly along the handle body 612). It is noted that in order to anticipate, a reference must disclose the identical invention in as complete detail as is contained in the claim. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, Applicants assert Rosenbluth does not anticipate claim 21, or likewise, claims 22-26 which depend from claim 21.

As to claim 34, Rosenbluth at least fails to teach a distal protection assembly including a proximal tubular member including teeth disposed within at least a portion of a manifold and coupled to the proximal end of an outer sheath. As discussed above, although Rosenbluth suggests teeth on a rack may be provided on the handle body 612 (see column 20, lines 63-65), this is not what is currently claimed. In order to anticipate, a reference must disclose the identical invention in as complete detail as is contained in the claim. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, Applicants assert Rosenbluth does not anticipate claim 34, or likewise, claims 35-39 which depend from claim 34.

Claims 1-5, 9-13, 21-26 and 34-39 are believed patentable over Rosenbluth at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

Claims 1-7 and 34-36 stand rejected under 35 U.S.C. §102(e) as being anticipated by Sisskind et al. (U.S. Patent No. 6,355,051). Applicants respectfully traverse this rejection.

As to claim 1, Sisskind at least fails to teach a manifold coupled to the proximal end of the inner shaft and an actuator assembly coupled to the proximal end of the outer shaft. Sisskind teaches an activation handle 38 including a ratcheting/locking mechanism 40 and a casing 41. See Figure 4 and column 6, lines 43-67. It appears that the ratcheting/locking mechanism 40 is coupled to the activation wire 24 and is for pulling and pushing on the activation wire 24. See column 6, lines 57-59. Therefore, the casing 41 must be coupled to the hollow tube 12 in order to provide a means for pulling the actuating wire 24 relative to the hollow tube. See column 6, lines 48-51. With this understanding of Sisskind, it is clear that Sisskind fails to teach a distal protection assembly having all of the elements and limitations of claim 1. Namely, the activation

wire 24 is disposed within the hollow tube 12 (see Figure 1), thus the elements of Sisskind are not coupled to analogously identified elements as defined in claim 1. In order to anticipate, a reference must disclose the identical invention in as complete detail as is contained in the claim. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, Sisskind fails to teach an actuator assembly including a button and a gear as provided in claim 1. Therefore, Applicants assert Sisskind does not anticipate claim 1, or likewise, claims 2-7 which depend from claim 1.

As to claim 34, Sisskind at least fails to teach the arrangement of elements necessary to show anticipation as discussed above regarding claim 1. Additionally, Sisskind fails to teach a proximal tubular member including teeth as currently claimed in claim 34. Therefore, Applicants assert Sisskind does not anticipate claim 34, or likewise, claims 35-36 which depend from claim 34.

Claims 1-7 and 34-36 are believed patentable over Sisskind at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

Claims 1-7 and 34-36 stand rejected under 35 U.S.C. §102(e) as being anticipated by Turovskiy et al. (U.S. Patent Publication 2002/0128679). Applicants respectfully traverse this rejection.

As to claim 1, Turovskiy at least fails to teach a manifold coupled to the proximal end of the inner shaft and an actuator assembly coupled to the proximal end of the outer shaft. In discussing the teachings of Turovskiy, attention is directed to paragraph 62 and Figure 2B. Turovskiy teaches a filter assembly 12 mounted on the distal end of an elongate member 11. The elongate member 11 is in turn attached to mechanism 5 included in filter delivery cartridge 14. The filter may be collapsed and retracted into the lumen of the introducer 15 when mechanism 5 slides proximally in slot 6. Therefore, it is clear that Turovskiy fails to teach a distal protection assembly having all the limitations of claim 1. Namely, the mechanism 5 is attached to the elongate member 11, an inner shaft of the device. Thus, the teachings of Turovskiy do not support the arrangement of elements and limitations provided in claim 1. In order to anticipate, a reference must disclose the identical invention in as complete detail as is contained in the claim. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913,

1920 (Fed. Cir. 1989). Furthermore, Turovskiy fails to teach an actuator assembly including a button and a gear as provided in claim 1. Therefore, Applicants assert Turovskiy does not anticipate claim 1, or likewise, claims 2-7 which depend from claim 1.

As to claim 34, Turovskiy fails to teach the arrangement of elements and limitations recited in claim 34. As previously noted, in order to anticipate, a reference must disclose the identical invention in as complete detail as is contained in the claim. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, Turovskiy fails to teach a proximal tubular member including teeth as currently claimed. Therefore, Applicants assert Turovskiy does not anticipate claim 34, or likewise, claims 35-36 which depend from claim 34.

Claims 1-7 and 34-36 are believed patentable over Turovskiy at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

Claims 1 and 6-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Makower et al. (U.S. Patent No. 5,324,306). Applicants respectfully traverse this rejection.

As to claim 1, Makower at least fails to teach a manifold coupled to the proximal end of the inner shaft and an actuator assembly coupled to the proximal end of the outer shaft. Makower, at Figure 6, seems to teach a handle fitted to the proximal end of a tubular outer sheath 76. See column 7, line 55 through column 8, line 29. A tubular pusher 82 extends into handle 72 through the lumen of the tubular sheath 76. The proximal end of the tubular pusher 82 includes a gear rack 84. See column 8, lines 10-12. Therefore, it is apparent that Makower fails to teach a distal protection assembly having all of the elements and limitations of claim 1. Namely, the handle 72 is coupled to the tubular sheath 76 and not to the pusher 82, an arrangement necessary in order to meet relevant limitations of claim 1. Again, Applicants note a claim is not a parts list and a reference must disclose the identical invention in as complete detail as is contained in the claim in order to anticipate. See M.P.E.P. §2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, Makower fails to teach an actuator assembly including a button and a gear. Therefore, Applicants assert

Makower does not anticipate claim 1, or likewise, claims 6-10 which depend from claim 1.

Claims 1 and 6-10 are believed patentable over Makower at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

§103 Rejections

Claims 9-13, 21-30 and 37-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sisskind et al. (U.S. Patent No. 6,355,051) in view of Makower et al. (U.S. Patent No. 5,324,306). Applicants respectfully traverse this rejection.

Noting the remarks provided above, Applicants assert neither Sisskind nor Makower teach that which is claimed in claim 1. The suggested combination fails to remedy the shortcomings of the references individually. Since the combination still fails to teach each and every limitation of claim 1, a requirement necessary to establish a *prima facie* case of obviousness, Applicants assert claims 9-13, which depend from claim 1, are indeed patentable over the cited combination for at least these reasons.

Additionally, the suggested combination fails to teach each and every limitation of claim 21. Namely, the claimed arrangement of elements is not suggested by either Makower or Sisskind. For at least this reason, no *prima facie* case has been established for claim 21. Applicants assert claim 21, and likewise, claims 22-30 are indeed patentable over the cited combination.

Futhermore, the suggested combination fails to teach each and every limitation of claim 34, of which claims 37-42 depend. Namely, the claimed arrangement of elements, including a proximal tubular member including teeth which is coupled to the proximal end of an outer sheath, is not suggested by either Makower or Sisskind. For at least this reason, no *prima facie* case has been established for claims 37-42, which depend from claim 34.

Claims 9-13, 21-30 and 37-42 are believed patentable over the cited combination for at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

Claims 9-13, 21-30 and 37-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Turovskiy et al. (U.S. Patent Publication 2002/0128679) in view of

Makower et al. (U.S. Patent No. 5,324,306). Applicants respectfully traverse this rejection.

Noting the remarks provided above, Applicants assert neither Turovskiy nor Makower teach that which is claimed in claim 1. The suggested combination fails to remedy the shortcomings of the references individually. Since the combination still fails to teach each and every limitation of claim 1, a requirement necessary to establish a *prima facie* case of obviousness, Applicants assert claims 9-13, which depend from claim 1, are indeed patentable over the cited combination for at least these reasons.

Additionally, the suggested combination fails to teach each and every limitation of claim 21. Namely, the claimed arrangement of elements is not suggested by either Makower or Turovskiy. For at least this reason, no *prima facie* case has been established for claim 21. Applicants assert claim 21, and likewise, claims 22-30 are indeed patentable over the cited combination.

Futhermore, the suggested combination fails to teach each and every limitation of claim 34, of which claims 37-42 depend. Namely, the claimed arrangement of elements, including a proximal tubular member including teeth which is coupled to the proximal end of an outer sheath, is not suggested by either Makower or Turovskiy. For at least this reason, no *prima facie* case has been established for claims 37-42, which depend from claim 34.

Claims 9-13, 21-30 and 37-42 are believed patentable over the cited combination for at least for the reasons stated above. Therefore, withdrawal of this rejection is respectfully requested.

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenbluth et al. (U.S. Patent No. 6,685,722) in view of Sisskind et al. (U.S. Patent No. 6,355,051). Applicants respectfully traverse this rejection.

As discussed above, neither Rosenbluth nor Sisskind teach all the elements and limitations claimed in claim 1. Furthermore, the cited combination fails to remedy the deficiencies the references possess individually. Claims 6 and 7 depend from claim 1 and add significant additional elements. Therefore, Applicants assert a *prima facie* case of obviousness has not been established with the cited combination. Thus, claims 6 and 7 are believed patentable and withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612-677-9050.

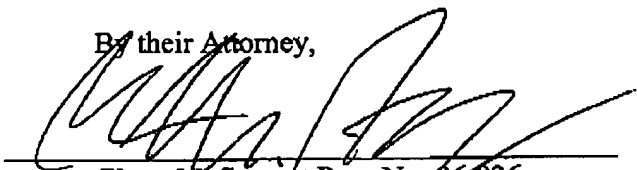
Respectfully submitted,

THOMAS DEYETTE, JR., ET AL.

By their Attorney,

Date:

April 6, 2005



Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050